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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,821	11/24/2003	Douglas B. Wilson	114089.120	5355
23483	7590	05/13/2010	EXAMINER	
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109				LUONG, VINH
ART UNIT		PAPER NUMBER		
3656				
NOTIFICATION DATE			DELIVERY MODE	
05/13/2010			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/720,821	WILSON, DOUGLAS B.	
	Examiner	Art Unit	
	Vinh T. Luong	3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 April 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input checked="" type="checkbox"/> Other: <u>Appendix</u> . |

1. The amendment filed on February 24, 2010 has been entered.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, "an upper one-half (1/2)" in claims 20 and 27. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.
3. The information disclosure statement (IDS) filed January 11, 2010 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Examiner respectfully submits that a review of the above IDS shows that Applicant submitted: (a) the English abstract, not the copy of each cited foreign patent document; and (b) an incomplete copy of the Office action of the Japanese Patent Office dated November 2, 2009 (only page 3 has been received). Please see MPEP § 609.04(a).

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 20-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (JP 4-78769 cited in Applicant's IDS).

Claim 20

Shigeru teaches a fatigue relieving/preventing apparatus associated with a steering wheel 2 for controlling a vehicle comprising:

a first section (at a' in FIG. 2, see Appendix hereinafter "App.") that connects to *an upper one-half* of a peripheral portion of the steering wheel (FIG. 1);

a second section (at 1 in FIG. 1 or 2, see App.) extends from the first section at the peripheral portion of the steering wheel 2, the second section extends from the first section outward at an angle (α in App., FIG. 4) to a plane across a face to the steering wheel 3 (FIG. 4 or 5), the second section is capable of providing resting support for at least a portion (e.g., the hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel 2. Shigeru, pp. 1 and 4 of translation.

Claim 21

The second section is deformable in at least one direction when deforming pressure is applied to such second section since it is made of a flexible cushion material 9 (FIG. 3). Shigeru, pp. 3 and 4 of translation.

Claim 22

The second section provides resting support for a portion of the vehicular operator's body when resting support pressure from such body portion is applied in at least one direction. Shigeru, pp. 1 and 4 of translation.

Claim 23

The steering wheel 2 includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

Claim 24

The second section will return to an original first position after deforming pressure is removed therefrom since it is made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, p. 3 of translation.

Claim 25

The portion of the body supported by the second section includes at least a forearm, wrist, or hand. Shigeru, p. 3 of translation.

Claim 26

The first section (at a' in FIG. 2) extends a length of a predetermined peripheral portion of the steering wheel 2 (FIG. 1).

Claim 27

Shigeru teaches at least a first first section (on the left of the steering wheel 2 shown in FIG. 1, see App.) and a second first section (on the right of the steering wheel 2 shown in FIG. 1, see App.) that connect to an upper one-half of a peripheral portion of the steering wheel 2, and

at least a first second section (at 1 on the left of the steering wheel 2 shown in FIG. 1, see App.) and a second second section (at 1 on the right of the steering wheel 2 shown in FIG. 1, see App.) that connect to, and extends from the first and second first sections (FIG. 1), respectively, with the first and second second sections extending from the respective first and second first sections outward at an angle (α in App., FIG. 4) to a plane across a face to the steering wheel 2, the first and second second sections, each providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section is less than the pressure for deforming the first or second second

section out of interference with the vehicular operator's ability to operate the steering wheel 2, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 2 when pressure from the portion of the vehicular operator's body on the first or second section is equal to or greater than the pressure for deforming the first or second section out of interference with the vehicular operator's ability to operate the steering wheel 2.

Claim 28

The first and second first sections are deformable since they are made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, pp. 3 and 4 of translation.

Claim 29

The first section (at a' in FIG. 2) is deformable since it is made of a flexible cushion material 8, 9 such as light weight plastic. Shigeru, pp. 3 and 4 of translation.

6. Claims 20-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 14-17, 24, and 27 of copending Application No. 10727306 (hereinafter "Appl.'306").

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-26 of this application and claims 14-17, 24, and 27 of Appl.'306 claim common structures such as a first section and a second section connected to the first section. To the extent that claims 14-17, 24, and 27 in Appl.'306 call for the second section being *rigid*, *semi-rigid*, *flexible*, or deformable, meanwhile, claims 20-26 in this application call for the second section being deformable, however, the terms "rigid," "semi-rigid," "flexible," and "deformable" are relative terms. See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969) ("Flexibility" and "rigidity" are relative terms, particularly since virtually anything will

flex if enough pressure is applied to it.). On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP § 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in claims 20-26 of this application such that it is rigid, semi-rigid, or flexible as claimed in claims 14-17, 24, and 27 of Appl.'306 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 27 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 19/18 of copending Appl.'306.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 27 and 28 of this application and claims 18 and 19/18 of Appl.'306 claim common structures such as at least two second sections (*i.e.*, a first second section and a second second section) that each connected to the first section at separate location. To the extent that claims 18 and 19/18 in Appl.'306 call for the second section being rigid, semi-rigid, flexible, or deformable, meanwhile, claims 27 and 28 in this application call for the second section being deformable, however, the terms "rigid," "semi-rigid," "flexible," and "deformable" are relative terms. In fact, when the second section is rigid, semi-rigid or flexible, it is inherently deformable if enough pressure is applied to it. *Fredman v. Harris-Hub Co., Inc., supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the at least two second sections claimed in claims 27 and 28 of this application such that they are rigid, semi-rigid, or flexible as claimed in claims 18 and 19/18 of Appl.'306 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ochiai (FIGS. 5 and 6).

9. Applicant's arguments filed February 24, 2010 have been fully considered but they are not persuasive.

At the outset, the previous objection to the specification and rejection under 35 USC 112 are withdrawn in view of Applicant's remarks and amendments to the claims. In addition, the previous art rejections based on Anson, Gemma, and Park are withdrawn in view of Applicant's amendments to the claims. Applicant's arguments with respect to claims 20-29 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the obviousness-type double patenting, Applicant contended (Amend. pp. 21 and 22):

The acceptance by the Examiner of the terminal disclaimer in the 306 Application will mean that the patent terms of the present application and 306 Application have already been tied to each other. Accordingly, Applicant submits that *in light of the terminal disclaimer being filed and accepted with respect to the 306 Application, it is improper to file a terminal disclaimer in the present application as suggested by the Examiner.* Accordingly,

Applicant requests that this rejection be withdrawn with respect to claims 20-26 and 29. (Emphasis added).

The Examiner respectfully submits that MPEP § 804.02 states:

*A terminal disclaimer filed to obviate a double patenting rejection is effective **only** with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. If an appropriate > “provisional” nonstatutory< double patenting rejection ** is made in >each of< two or more pending applications, **>the examiner should follow the practice set forth in MPEP § 804, subsection I.B.1. in determining in which of the applications an appropriate terminal disclaimer must be filed. (Emphasis added)*

In addition, MPEP § 804, subsection I.B.1. states:

1. Nonstatutory Double Patenting Rejections

*If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is **the only rejection** remaining in the earlier filed of the two pending applications, while the later filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.*

*If “provisional” ODP rejections in two applications are **the only rejections** remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. (Emphasis added)*

In the instant case, Appl.'306 is the later-filed application and this Appl.'821 is the earlier filed of the two applications. However, the obviousness-type double patenting rejection *is not the only rejection* remaining in this earlier filed of the two pending applications, meanwhile, the later filed Appl.'306 is also rejectable on other grounds. Hence, the Examiner respectfully declines to withdraw the obviousness-type double patenting rejection in this application without a terminal disclaimer because the terminal disclaimer filed to obviate the double patenting rejection in Appl.'306 is effective only with respect to Appl.'306 per MPEP *supra*.

In view of the foregoing, the Examiner respectfully submits that this case is not in the condition for allowance.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656